

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 27

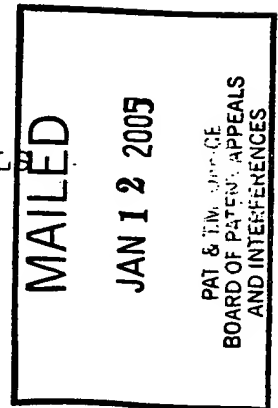
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HANS-DIETER BIPPUS and BRYCE LINDSAY NICHOLLS

Appeal No. 2004-0719
Application No. 09/856,788

HEARD: DECEMBER 8, 2004



Before JERRY SMITH, RUGGIERO, and GROSS, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the Examiner's final rejection of claims 12-17 and 25. Claims 1-11 and 18-24 have been canceled. An amendment filed January 8, 2003 after final rejection was approved for entry by the Examiner.

The claimed invention relates to a connection strip for electric wires in which a plurality of shielding plates are connected to a base rail via a narrow web. The shielding plates and base rail are integrally formed from a metal plate with each

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shielding plate rotated 90° with respect to the base rail.
According to Appellants (specification, page 3), the assembly of the connection strip is facilitated since the shielding plates integrally connected to the base rail are simultaneously inserted into preformed slots inside the connection strip.

Claim 12 is illustrative of the invention and reads as follows:

12. A connection strip, comprising:

a plastic housing;

insulation-piercing terminal contact elements arranged in said plastic housing;

shielding plates arranged between said insulation-piercing terminal contact elements; and

at least one base rail connected to said shielding plates, said shielding plates and said base rail being integrally formed from a metal sheet with each shielding plate being connected to said base rail via a web and being arranged rotated approximately 90° with respect to said base rail.

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The Examiner relies on the following prior art:¹

Simmack ²	DE 3625240 C2	May 5, 1988
(published German Patent Office Application)		
Buetler et al. (Petra) ³	EP 0766352 A2	July 24, 1996
(published European Patent Office Patent Application)		

Claims 12-17 and 25 stand rejected under 35 U.S.C. § 103(a)
as being unpatentable over Petra in view of Simmack.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs⁴ and Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the

¹ The Examiner's Answer lists the Itoga reference (U.S. Patent No. 5,762,516) as part of the prior art of record. This reference, however, was applied earlier in the prosecution against now canceled claims 7, 9, and 11 and forms no part of the rejection before us on appeal.

² Although the Examiner lists this reference as "Wieland" in the "**Prior Art of Record**" portion of the Answer, both the Examiner in the statement of the rejection and Appellants in their arguments refer to this reference by the inventor's surname Simmack. A copy of a translation provided by the U.S. Patent & Trademark Office July 2003 is enclosed with this decision.

³ Since both Appellants and the Examiner refer to this reference by the inventor's given name "Petra," we will do so also to maintain consistency.

⁴ The Appeal Brief was filed April 17, 2003 (Paper No. 18). In response to the Examiner's Answer dated July 29, 2003 (Paper No. 19), a Reply Brief was filed September 24, 2003 (Paper No. 21), which was acknowledged and entered by the Examiner as indicated in the communication dated December 4, 2003 (Paper No. 22).

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rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as recited in claims 12-17 and 25. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in

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the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to claim 12, the sole independent claim on appeal, Appellants' response to the obviousness rejection asserts a failure by the Examiner to establish a prima facie case of obviousness since proper motivation for the Examiner's proposed combination of references has not been set forth. After reviewing the arguments of record from Appellants and the Examiner, we are in general agreement with Appellants' position as stated in the Briefs.

In particular, we agree with Appellants (Brief, page 6; Reply Brief, page 2) that, while the Examiner may be correct in the assertion that there is no requirement that motivation to combine be expressly articulated in the prior art references, the

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Examiner must still provide evidence and support for the asserted conclusion of obviousness. We find the record before us totally lacking in any such evidence or support. "[T]he Board cannot simply reach conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings." In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). The Examiner must not only make requisite findings, based on the evidence of record, but must also explain the reasoning by which the findings are deemed to support the asserted conclusion. See In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002). The court has also recently expanded their reasoning on this topic in In re Thrift, 298 F.3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002).

We further agree with Appellants that the disclosures of Petra and Simmack, rather than providing any suggestion for their combination, in fact lead away from their combination. As recognized by Appellants, the disclosure of Petra is indeed directed to a shielding plate construction for a terminal block. Simmack, on the other hand, is directed to a bridging bar construction which connects wires together rather than shields or

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isolates them. In our view, the structural teachings of the Petra and Simmack references are so opposite in approach to the problems associated with terminal block construction that any motivation to combine them must have resulted from an improper attempt to reconstruct Appellants' invention in hindsight. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

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Accordingly, since we are of the opinion that the prior art applied by the Examiner does not support the obviousness rejection, we do not sustain the rejection of independent claim 12, nor of claims 13-17 and 25 dependent thereon. Therefore, the Examiner's decision rejecting claims 12-17 and 25 under 35 U.S.C. § 103(a) is reversed.

REVERSED

Jerry Smith

JERRY SMITH)
Administrative Patent Judge)

Joseph F. Ruggiero

JOSEPH F. RUGGIERO)
Administrative Patent Judge)

BOARD OF PATENT
APPEALS AND
INTERFERENCES

Anita Pellman Gross

ANITA PELLMAN GROSS)
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JFR:hh

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